REMARKS

In the Final Office Action mailed October 10, 2007 (Final Office Action), the Examiner objected to claims 1 and 14 for lacking "insufficient antecedent basis;" rejected claims 1, 6, 8-12, 14, and 18-20 under 35 U.S.C. § 102(b) as unpatentable over WO 01/88703 A1 to Hatcher, Clark et al. (Clark); rejected claims 4, 5, 13, 15, and 17 under 35 U.S.C. § 103(a) as unpatentable over Clark; and rejected claims 7 and 16 under 35 U.S.C. § 103(a) as unpatentable over Clark in view of U.S. Patent No. 7,000,182 to Iremonger et al. (Iremonger).

By this amendment, Applicants amend claims 1, 14, 15, and 18 to more clearly claim the features of those claims. Applicants submit that the amendments to claims 1, 14, 15, and 18 do not introduce new matter and are supported by the specification (see, e.g., p. 5, lines 11-25.) Applicants also amend claims 1 and 14 to respond to the Examiner's objection regarding antecedent basis. Applicants thus submit that the objection regarding antecedent basis should be withdrawn.

The Examiner rejected claims 1, 6, 8-12, 14, and 18-20 under 35 U.S.C. § 102(b) as unpatentable over Clark. Applicants respectfully traverse this rejection.

Amended claim 1 recites a combination of features including, among other things, "extracting, using a filter, at least one user-changeable code portion from the existing informational display, wherein at least one input field is bound to the extracted code portion, the filter recognizing the at least one user-changeable code portion from another portion not changeable by the user." At page 11, of the Final Office Action, the Examiner alleges that Clark teaches this feature "inherently." Applicants disagree.

Specifically, the Examiner alleges the following:

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Clark's invention ... teaches selecting an existing template by a user and generating a report based on the template. In order to use the existing template for generating a report, his [Clark's] invention necessarily requires reading at least one user changeable code portion from that template so that the report can be produced based on the template."

However, Clark'does not disclose any form of extracting using a filter, much less "extracting, using a filter, at least one user-changeable code portion from the existing informational display, ... the filter recognizing the at least one user-changeable code portion from another portion not changeable by the user," as recited in claim 1. Instead, Clark teaches away from claim 1 as Clark appears to allow all details to be defined by the user. Clark, page 5, lines 3-5. As such, there would be no reason in Clark's system to provide the following: "the filter recognizing the at least one user-changeable code portion from another portion not changeable by the user," as recited in claim 1. For at least this reason, Clark fails to disclose at least the following feature of claim 1: "extracting, using a filter, at least one user-changeable code portion from the existing informational display, wherein at least one input field is bound to the extracted code portion, the filter recognizing the at least one user-changeable code portion from another portion not changeable by the user." Therefore, the rejection under 35 U.S.C. § 102(b) of claim 1 as well as claims 6 and 8-12, at least by reason of their dependency from independent claim 1, should be withdrawn.

Moreover, conspicuously absent from the Examiner's inherency allegation on page 11 of the Final Office Action is any citation to Clark. Instead, the Examiner uses impermissible hindsight by citing to Applicants' own disclosure. For this additional reason, the rejection under 35 U.S.C. § 102(b) of claim 1 as well as claims 6 and 8-12, at least by reason of their dependency from independent claim 1, should be withdrawn.

Furthermore, Applicants disagree that "extracting," as recited in claim 1, is inherent in <u>Clark</u>. Inherency requires that the Examiner's allegation **necessarily** be the case, and Applicants submit that <u>Clark</u>'s reading functionality does not necessarily constitute extracting using a filter, much less "extracting, using a filter, at least one user-changeable code portion from the existing informational display, ... the filter recognizing the at least one user-changeable code portion from another portion not changeable by the user," as recited in claim 1.[1] Indeed, even <u>Clark</u> states that a new report may be created in "one of two ways" a "report wizard" and a "report writing component," neither of which necessarily requires "extracting, using a filter," as recited in claim 1. (<u>Clark</u>, page 18, line 36 - page 19, line 5.) For this additional reason, the rejection under 35 U.S.C. § 102(b) of claim 1 as well as claims 6 and 8-12, at least by reason of their dependency from independent claim 1, should be withdrawn.

Independent claims 14 and 18, although of different scope, include features similar to those noted above for claim 1. For at least the reasons given above with respect to claim 1, the rejection under 35 U.S.C §102(b) of independent claims 14 and 18, and claims

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[1] M.P.E.P 2112 states the following with respect to inherency: The fact that a certain result or characteristic **may** occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993) (reversed rejection because inherency was based on what would result due to optimization of conditions, not what was necessarily present in the prior art); *In re Oelrich*, 666 F.2d 578, 581-82, 212 USPQ 323, 326 (CCPA 1981). "To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is **necessarily** present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.' " *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999) (emphasis added).

19-20, at least by reason of their dependency from corresponding independent claim 18, should be withdrawn.

The Examiner rejected claims 4, 5, 13, 15, and 17 under 35 U.S.C. § 103(a) as unpatentable Clark. Applicants respectfully traverse this rejection.

Claims 4, 5, and 13 each depends from independent claim 1 and each includes all the features recited therein including, among other things, "extracting, using a filter, at least one user-changeable code portion from the existing informational display, wherein at least one input field is bound to the extracted code portion, the filter recognizing the at least one user-changeable code portion from another portion not changeable by the user." For at least the reasons given above with respect to claim 1, Clark fails to disclose the noted feature of claims 4, 5, and 13. Claims 4, 5, and 13 are thus allowable over Clark, and the rejection of those claims under 35 U.S.C. § 103(a) should be withdrawn.

Claim 15 recites a combination of features including, among other things, "extracting, using a filter, at least one user-changeable code portion from the template file according to the layout and placing the code portion in an XML file, the filter recognizing the at least one user-changeable code portion from another portion not changeable by the user." For at least the reasons given above with respect to claim 1, Clark fails to disclose the noted feature of claim 15. Claim 15 and claim 17, at least by reason of its dependency from independent claim 15, are thus allowable over Clark, and the rejection of those claims under 35 U.S.C. § 103(a) should be withdrawn.

The Examiner rejected under 35 U.S.C. § 103(a) claims 7 and 16 as unpatentable over Clark in view of Iremonger.

Claim 7 depends from claim 1, and claim 16 depends from claim 15. For at least the reasons noted above, Clark fails to disclose or suggest at least the "extracting"

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features included in each of those claims by virtue of their dependency from independent claims 1 and 16. Moreover, <u>Iremonger</u> fails to cure the noted-deficiencies of <u>Clark</u>. Claims 7 and 16 are thus allowable over <u>Clark</u> and <u>Iremonger</u>, whether taken alone or in combination, and the rejection of those claims under 35 U.S.C. §103(a) should be withdrawn.
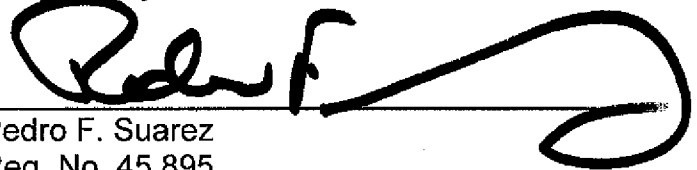
CONCLUSION

Applicants respectfully request that this Amendment under 37 C.F.R. § 1.116 be entered by the Examiner. Applicants submit that the proposed amendments do not raise new issues or necessitate the undertaking of any additional search of the art by the Examiner. Therefore, this Amendment should allow for immediate action by the Examiner. Finally, Applicants submit that the entry of the amendment would place the application in better form for appeal, should the Examiner continue to dispute the patentability of the pending claims.

It is believed that all of the pending claims have been addressed in this paper. However, failure to address a specific rejection, issue or comment, does not signify agreement with or concession of that rejection, issue or comment. In addition, because the arguments made above are not intended to be exhaustive, there may be reasons for patentability of any or all pending claims (or other claims) that have not been expressed. Finally, nothing in this paper should be construed as an intent to concede any issue with regard to any claim, except as specifically stated in this paper, and the amendment of any claim does not necessarily signify concession of unpatentability of the claim prior to its amendment.

On the basis of the foregoing amendments, Applicants respectfully submit that the pending claims are in condition for allowance. If there are any questions regarding these amendments and remarks, the Examiner is encouraged to contact the undersigned at the telephone number provided below. No fee is believed to be due, however, the Commissioner is hereby authorized to charge any fees that may be due, or credit any overpayment of same, to Deposit Account No. 50-0311, Reference No. 34874-095/2004P00159US

Respectfully submitted,

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